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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/490,038	01/24/2000	Taro Takahashi	US000034	6624

7590 08/26/2003  
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EXAMINER

OH, TAYLOR V

ART UNIT PAPER NUMBER

1625

DATE MAILED: 08/26/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/490,038		<b>Applicant(s)</b> TAKAHASHI ET AL.	
	<b>Examiner</b> Taylor Victor Oh		<b>Art Unit</b> 1625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 13 June 2003.

2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-15 is/are pending in the application.

4a) Of the above claim(s) 8-10 is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☐ Claim(s) 1, 11 and 12 is/are rejected.

7) ☐ Claim(s) 13-15 is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All   b) ☐ Some \*   c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____
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***Final Rejection***

**The Status of Claims**

Claims 1 and 11-12 have been rejected.

Claims 2-7 have been canceled.

Claims 13-15 have been objected.

**Claim Rejections-35 USC 112**

1. Applicants' argument filed 6/13/2003 have been fully considered but they are not persuasive.

The rejection of Claims 4 and 7 under 35 U.S.C. 112, second paragraph, has been withdrawn due to the modification made in the amendment. However, the rejection of Claim 1 is still maintained due to the new issues in the amendment. For examples, the phrase "the salts thereof" is recited. However, this is vague and indefinite. There are no specific salts corresponded to the claimed carboxylic acid compounds. In addition, the phrase "peptides and amino acids obtained from the decomposition thereof" is recited. However, this is vague and indefinite. There are numerous peptides and amino acids to be produced as a result of the decomposition of various proteins. There are no specific amino acids and peptides described in the claim. Therefore, an appropriate correction is required.

**Claim Rejections-35 USC 102**

The rejection of Claims 7 and 11 under 35 U.S.C. 102(b) as being anticipated clearly by Madsen et al (U.S. 5,189,016) has been withdrawn due to the modification in the amendment.

**Claim Rejections-35 USC 103**

Rejection of Claims 1 and 11-12 under 35 U.S.C. 103(a) as being unpatentable over van Pottelsberghe dela Potterie (U.S. 3,716,380) in view of Goldberg (Schaum's Beginning Chem., P. 250).

The rejection of Claims 1 and 11-12 under 35 U.S.C. 103(a) as being unpatentable over van Pottelsberghe dela Potterie (U.S. 3,716,380) in view of Goldberg (Schaum's Beginning Chem., P. 250) is maintained for reasons of the record in paper no. 16.

The rejection of Claims 1, 2 and 5 under 35 U.S.C. 103(a) as being obvious over Heins et al (U.S. 4,032,676) in view of Goldberg (Schaum's Beginning Chem., P. 250) has been withdrawn due to the modification in the amendment.

Claims 13-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Argument***

2. The applicants argue the following issue:

1. unlike the disclosure of the Heins reference, the claimed method is carried out in the absence of a catalyst;
2. the Heins reference is directed to cosmetic preparations and not food products and there is motivation to increase the pressure and temperature of the reaction to arrive at the claimed invention;
3. there is no teaching in the Potterie reference that the carboxylic acid provided in the reaction medium is reacted with any of the amino acids disclosed in the claimed method , thereby failing to arrive at the claimed invention;
4. there is no motivation to increase the pressure and temperature of the reaction to arrive at the claimed invention because an increase in temperature in an aqueous system beyond the boiling point (100° C) can

result in the thermal destruction of the reactants or the desired end products, thereby producing toxic substances to human ingestion.

The applicants' argument have been noted, but these arguments are not persuasive.

First, with regard to the first and second arguments, the Examiner has noted applicants' argument. However, the rejection based on the Heins et al and the Goldberg references has been withdrawn.

Second, regarding the third argument, the Examiner has noted applicants' argument. However, in view of Example 2 in the Potterie reference, there are some substances at the claimed ratio between (100 :1 to 1: 100) to be heated at 100<sup>0</sup> C : Hydrolysed plant protein in 26.55 parts, Palmitic acid in 0.47 parts. As a result, this limitation reads on claims 11 and 12. Therefore, the Potterie reference is relevant to the claimed invention.

Third, regarding the fourth argument, the Examiner has noted applicants' argument. However, with respect to producing toxic substances to human ingestion above 100<sup>0</sup> C, generally, this may not be true. This depends on the stability of the end products. Some condensate products between vegetable proteins and the carboxylic acid are heat-stable. Furthermore, the claimed temperature range and prior art are close enough, although they do not overlap, that one skilled in the art would have

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expected them to have the same reaction condition in the absence of an unexpected result. Therefore, it would have been obvious to the skilled artisan in the art to have motivated to ascertain the optimum range of the desired reaction temperature by routine experimentation.

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 703-305-0809. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on 703-308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-2742 for regular communications and 703-305-7401 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

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*[Handwritten signature]*  
8/22/03

*Alan L Rotman*  
ALAN L. ROTMAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600